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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,489	01/20/2004	Daniel C. Griffin	MS1-1804US	4377
22801 7590 04/15/2011 LEE & HAYES, PLLC 601 W. RIVERSIDE AVENUE SUITE 1400 SPOKANE, WA 99201				
EXAMINER WEST, THOMAS C				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 04/15/2011		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhptoms@leehayes.com

### Office Action Summary

**Application No.**

10/761,489

**Applicant(s)**

GRIFFIN ET AL.

**Examiner**

THOMAS WEST

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 9, 12, 17, 19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9, 12, 17, 19, 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11-24-10
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 24, 2010 has been entered.
2. Claims 1, 9, 12, 15, 17, 19, 21-24 are currently pending and have been examined.

### ***Information Disclosure Statement***

3. The Information Disclosure Statements filed on November 24, 2010 has been considered. An initialed copy of Form 1449 is enclosed herewith.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 9, 12, 15, 17, 19, 21-24 are rejected under U.S.C. 103(a) as being unpatentable over Hamann et al., U.S. Patent Application No. 2002/0026578

("Hamann"), in view of Dancs, U.S. Patent No. 6,108,789 (Dancs), in view of Skomora, U.S. Patent Application No. 20050076198, in view of Palaniswamy, U.S. Patent No. 6951095.

**Claims 1, 9, 17, 21, 23:**

Hamann, as shown, discloses

determining if a smartcard is operatively available, said smartcard having smartcard memory (see at least paragraphs 36, 46)

identifying a root certificate stored in said smartcard memory (verification of digital signature, checking availability of public root key), and storing a root certificate (see at least paragraphs 5, 6, 31, 33, 36).

reading said root certificate from said smartcard memory (see paragraph 39)

storing said root certificate in a computer memory of a computing device operatively coupled to said smartcard (see paragraph 32, user's client system)

wherein the storing comprises copying said root certificate from the smartcard to a certificate store maintained in said computer memory (see paragraph 46)

authentication by the smartcard (see paragraphs 30-41, 46)

Hamann discloses the limitations as shown above. Hamann does not directly disclose the following limitation, but Dancs teaches:

requiring entry of a password (see at least col. 7, lines 23-40)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hamann to include the password of Dancs since this allows for

access control of the smartcard through a PIN or password, to prevent fraudulent use.

Hamann/Dancs discloses the limitations as shown above including a root certificate. Hamann/Dancs does not directly disclose the following limitation, but Skomora teaches:

determining when said smartcard is no longer operatively available to the computing device; (see paragraphs 39, 114)

manage root certificate on said computing device when said smartcard is no longer operatively available (see paragraph 114).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hamann/Dancs to include the password of Skomora since this allows for the disabling of trust related processes on a device when the smart card is removed.

Hamann/Dancs does not directly disclose the following limitation, but Palaniswamy teaches

erasing said root certificate (col. 6, lines 4-67 untrusted certificate, col. 3, lines 34-67, col. 7, lines 32-45 check root present)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hamann/Dancs to include the password of Palaniswamy since this allows for the disabling of trust related processes on a device when the smart card is removed.

Alternatively, Hamann/Dancs discloses the limitations as shown above. Hamann/Dancs does not directly disclose the following limitations, but Palaniswamy teaches:

erasing said root certificate (col. 6, lines 4-67 untrusted certificate, col. 3, lines 34-67, col. 7, lines 32-45 check root present)

It would have been obvious to one of ordinary skill in the art to apply the erasing of a root certificate of Palaniswamy to the certificate management of Hamann/Dancs, the combination of which is taught by Palaniswamy and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claims 12, 19, 22, 24:**

Hamann, as shown, discloses authenticating information (see at least paragraphs 40, 41).

**Claim 15:**

Hamann discloses the limitations as shown above. Hamann does not directly disclose the following limitation, but Dancs teaches:

determining when an account associated with said smartcard is not active  
(see col. 2, lines 22-32)

no longer storing said root certificate in said device when said account is not active (see col.12, lines 24-30)

said account is associated with a user and determining when said account is not active includes determining is said user currently logged on (see col. 9, lines 33-49)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hamann to include the account activity, deletion of root certificate, and logon of Dancs since this allows for further access control of the smartcard through deletion of the certificate for an inactive account to prevent fraudulent use.

### ***Response to Arguments***

6. Applicant's arguments with respect to the claims 1, 9, 12, 15, 17, 19, 21-24 have been considered but are not persuasive. Applicant argues, regarding claims 1, 9, 12, 17, 19, 21, 22, 23, 24 that none of the cited references teach erasing said root certificate from said computing device operatively coupled to said smartcard in response to deterring that said smartcard is no longer operatively available. Palaniswamy teaches checking for a root certificate on a SIM (smart card) col.7, lines 32-45, and also teaches certificate management. Palaniswamy teaches "The actions that may be performed for a given certificate are: addition; deletion; mark untrusted (untrusted certificates cannot be used to verify applications or other certificates. This process may be preferred to certificate deletion as there is a chance that the certificate may become trusted again in the near future.); mark trusted (marking as trusted is the process of allowing an untrusted certificate to come into use again)" col. 6, lines 55-67.

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A certificate marked untrusted is synonymous with the erasure of a root certificate, since the certificate is unusable under both scenarios.



***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on Tuesday and Wednesday 7:30am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West  
Patent Examiner  
Art Unit 3621

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621